

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/317,407 10/03/94 CARLING C 1103326018

HENLE EXAMINER, R

12M1/0221

WHITE & CASE  
PATENT DEPARTMENT  
1155 AVENUE OF THE AMERICAS  
NEW YORK NY 10036

ART UNIT	PAPER NUMBER
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1205

DATE MAILED:

02/21/96

62/21/96

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

**Advisory Action**Application No. **412654**  
**08/317,304**  
**407**

Applicant(s)

**Christer C. G. Carling, et al.**

Examiner

**Ray Henley**

Group Art Unit

**1205****THE PERIOD FOR RESPONSE: [check only a) or b)]**

- a) ☒ expires 5 months from the mailing date of the final rejection.
- b) ☐ expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

- ☐ Appellant's Brief is due two months from the date of the Notice of Appeal filed on \_\_\_\_\_ (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

Applicant's response to the final rejection, filed on Jan 9, 1996 has been considered with the following effect, but is **NOT** deemed to place the application in condition for allowance:

- ☒ The proposed amendment(s):
- ☒ will be entered upon filing of a Notice of Appeal and an Appeal Brief.
  - ☐ will not be entered because:
    - ☐ they raise new issues that would require further consideration and/or search. (See note below).
    - ☐ they raise the issue of new matter. (See note below).
    - ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
    - ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

- ☐ Applicant's response has overcome the following rejection(s): \_\_\_\_\_  
\_\_\_\_\_

- ☐ Newly proposed or amended claims \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.
- ☒ The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
of the reasons of record and those attached hereto.
- ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
- ☒ For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):
- Claims allowed: none
- Claims objected to: none
- Claims rejected: 1, 2, 7, and 14-23
- ☐ The proposed drawing correction filed on \_\_\_\_\_ ☐ has ☐ has not been approved by the Examiner.
- ☐ Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Other

**RAYMOND HENLEY, III**  
**PRIMARY EXAMINER**  
**GROUP 1200**

## ATTACHMENT TO ADVISORY ACTION

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Applicants' amendment and the declaration of Jan William Trofast filed January 9, 1995 have been received and entered into the application. Accordingly, claim 1 has been amended.

On appeal, claims 1, 2, 7 and 14-23 would remain rejected under 35 U.S.C. § 103 as being unpatentable over Brattsand et al. and Murakami et al. in view of applicants' acknowledgements at page 3 of the present specification, for the reasons of record as set forth in the last Office action dated August 30, 1995 at pages 2 and 3.

Notwithstanding applicants' characterization of the cited case law, the Examiner maintains that none of the present claims are commensurate in scope with the evidence offered to show non-obviousness. This finding is based upon the fact that a synergistic result is manifestly unpredictable and it is not seen that one can extrapolate the unpredictable results demonstrated to include other, untested ratios or all ratios where effective amounts are employed.

The evidence presented by Dr. Trofast has been considered and would, when combined with the results shown in his declaration filed June 12, 1995, support the allowance of claims limited to a ratio of formoterol to budesonide which ranges from 1:1 to 1:60.